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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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Richard D. Martin

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9008

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02/03/2009

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EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT

PAPER NUMBER

2454

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |  |                                      |  |
|------------------------------|--|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/923,923   | <b>Applicant(s)</b><br>MARTIN ET AL. |  |
|                              | <b>Examiner</b><br>MOHAMMAD A. SIDDIQI | <b>Art Unit</b><br>2454              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 13-27 are presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/22/2008 has been entered.

#### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d) (1) and MPEP §608.01(o). Correction of the following is required: Claims 17-20 recites the limitation "computer-readable medium". There is insufficient antecedent basis for this limitation in the disclosure. Claim 17 recites "computer-readable medium encoded with computer-executable instructions", the statement "computer-readable medium encoded with computer-executable instructions" interpreted as a computer program is on shelf waiting to be

“performing” computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer readable medium needed to realize the computer program’s functionality, as nonstatutory functional descriptive material. Examiner suggestion would be to amend the specification on page 15 by suggesting example of computer readable media are storage device, memories etc.

***Claim Rejections - 35 USC § 101***

4. Claims 13-16 and 21-27 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The method in claims 13 and 21 including steps of constructing web page and inserting script in to the web page are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent. For example a web page can be constructed on the piece of paper that allows receipt of digital asset.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 13-24 are rejected under 35 U.S.C. 102(b) as being unpatentable as being anticipated by Truong et al (US 6,151,609) (Hereinafter Truong).

6. As per claim 13, Truong teaches a method of constructing a web page that allows for syndication of digital assets, the method comprising:

- (a) constructing a web page (Figs, 4 and 5); and
- (b) inserting into the web page script (col 2, lines 17-31) associated with at least one digital asset that is desired to be part of a fully rendered web page (col 2, lines 17-31) , the inserted script including code to request the content of the digital asset (server file, col 10, lines 5-14) from a remote site when the code is executed by a browser (col 8, lines 3-16), the code including a uniform resource identifier (URI) (col 7, lines 20-33) of a web page for use by the remote site in authenticating whether the URL is authorized to receive the content of the digital asset (col 8, lines 3-16), and a unique identifier of the selected content of the digital asset (col 7, lines 20-33; col 8, lines 3-16).

7. As per claim 14, Truong teaches the scripting language is JavaScript (col 9, line 19).

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8. As per claim 15, Truong teaches a method of claim 13 wherein the content is an executable file (server file, col 10, lines 5-14).

9. As per claim 16, Truong teaches a method of claim 13 wherein the script includes a subscriber identifier and a content identifier (fig 4-5, Logon ID/ password), which together, create the unique identifier of the selected content (Path, col 8, lines 17-37).

10. Claims 17 and 21 do not teach or define any new limitations above claim 13 and therefore are rejected for similar reasons.

11. Claims 18 and 22 do not teach or define any new limitations above claim 12 and therefore are rejected for similar reasons.

12. Claims 19 and 23 do not teach or define any new limitations above claim 15 and therefore are rejected for similar reasons.

13. Claims 20 and 24 do not teach or define any new limitations above claim 16 and therefore are rejected for similar reasons.

14. As per claims 25-27, Truong teaches wherein the script is a scripting language (col 9, line 19).

### ***Response to Arguments***

15. Applicant's arguments with respect to claims 13- 27 have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Component framework for Web-based learning environments by Lindquist, T.E. Gary, K.A. Koehnemann, H.E. Naccache, H; This paper appears in: Frontiers in Education Conference, 1999. FIE '99. 29th Annual; Publication Date: 1999 Volume: 2, On page(s): 12C3/23-12C3/28 vol.2; Meeting Date: 11/10/1999 - 11/13/1999; (all pages).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD A. SIDDIQI whose telephone number is (571)272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS\

/Nathan J. Flynn/  
Supervisory Patent Examiner, Art Unit 2454